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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,981	02/11/2004	David A. Arias	0088777	4572

7590 09/28/2004

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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,981

Applicant(s)

ARIAS, DAVID A.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/11/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

The species are as follows:

group I, the species shown in Figs 1-4 and 6;

group II, the species shown in Fig 5;

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1 appears generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Peter Shaddock on Friday July 23, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-12 and 18-19. Affirmation of this election must be made by applicant in replying to this Office action. Claim 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

An action on the merits of the claims drawn to the elected invention follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from the specification what the applicant considers to be a naturally weighted material or naturally buoyant material respectively?

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 2-3, 8-12 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 2: the phrase “the aquatic toy is in the general shape of an object, plant, animal, or other character” is confusing since it is not clear what other character is the applicant referring to? Note also claims 8 and 12 in similar regard.

With respect to claim 3: the phrase “at least one of a woven fabric, a sheet fabric, a film, nylon, spandex, vinyl, Polyvinyl Chloride, neoprene, or an equivalent” is confusing since the specific object that the applicant is claiming cannot be determined.

With respect to claim 10: the phrase “at least one of foam, Styrofoam or any other multicellular expanded synthetic resin, cork, an inflated or inflatable pocket or bladder, plastic, rubber, wood, or an equivalent, or any other known or later developed material or system” is confusing?

Claim 9 is indefinite since all that the applicant considers to be encompassed by the phrase “a determined relatively buoyancy” cannot be determined. Note also claims 11 and 18-19 in similar regard.

With respect to claims 18 and 19: it is not clear what the applicant considers as “a naturally weighted material” or “a naturally buoyant material” respectively?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 8 and 11-12 rejected under 35 U.S.C. 102(b) as being anticipated by Van Meter.

Van Meter discloses in Fig 3, a toy comprising: a fabric portion [col 2 lines 1-6], at least one hollow opening [chamber 19] and at least one weight element [threaded stud 7].

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions such as those set forth in the preamble of the claim.

9. Claims 1-13 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenberg et al, hereinafter Greenberg.

Greenberg discloses in the embodiment of Figs 1-3c, an aquatic toy that is capable of maintaining a desired form and position in water, comprising: a fabric portion [col 4 first paragraph], at least one hollow opening 7 formed in the fabric portion comprising multiple materials [polyvinyl chloride] having a negative buoyancy [in Fig 3c, area where the weight 5 is located], at least a portion of the fabric portion has a neutral buoyancy [in Fig 3c, area between openings 7 and 8] and at least a portion of the fabric portion has a positive buoyancy [area where the air is trapped]. Additionally, Greenberg

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discloses that a general overall geometry of the hollow opening is that of circular shape, at least one buoyancy element [trapped air] and at least one weight element 5.

Claim Rejections - 35 USC § 103

10. Claims 1-13 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg in view of Alexander.

Greenberg discloses in the embodiment of Figs 4-5, an aquatic toy that is capable of maintaining a desired form and position in water, comprising: a fabric portion [either cloth layer 10 in Fig 4 or woven material 15 in Fig 5], the fabric portion comprising multiple materials [polyester] having a negative buoyancy [area where either cloth sack 12 and sand 13 in or weighted end 16 is located], at least a portion of the fabric portion has a neutral buoyancy [the area in the middle of the stick] and at least a portion of the fabric portion has a positive buoyancy [enlarged end 14]. Additionally, Greenberg discloses at least one buoyancy element [trapped air] and at least one weight element [either cloth sack 12 and sand 13 in Fig 4 or weighted end 16 in Fig 5].

Greenberg does not disclose at least one hollow opening formed in the fabric portion in a general overall geometry of circle.

Alexander teaches the concept of providing an aquatic toy [col 1 line 20] that is capable of maintaining a desired form and position in water [Fig 1] via weight of a ball 15 which hold the toy in a vertical attitude in water wherein the toy is in the shape of a circular hoop having one hollow opening. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Greenberg in the shape of a circular hoop having one hollow opening as taught by Alexander in order

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for the swimmers to swim through the loop of the hoop before grasping the toy, making the device more fun to play with.

11. Claims 1-2, 8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Kessler.

Alexander discloses in the embodiment of Figs 1-3, an aquatic toy that is capable of maintaining a desired form and position in water, comprising: a hoop having one hollow opening in a general overall geometry of circle and at least one weight element [ball15].

Alexander does not disclose a fabric portion.

Kessler teaches that it is conventional to provide a hoop with a cover [see the abstract]. It would have been obvious, in view of Kessler to provide the device of Alexander with the missing element in order to provide the device with individualized appearance.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



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